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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,644	04/11/2001	Steven Dickinson Potter		1632

7590 05/07/2002  
Steven D. Potter  
114 Harnden Ave.  
Watertown, MA 02472

EXAMINER

RESTIFO, JEFFREY J

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/832,644

Applicant(s)

POTTER, STEVEN DICKINSON

Examiner

Jeffrey J. Restifo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 8-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species A in figures 1-5, species B in figures 6-7, species C in figures 8-10, species D in figures 11-13, and species E in figure 14.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 13 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Steven D. Potter on 2/30/02 a provisional election was made of species A without traverse to prosecute the invention of figures 1-5, claims 1, 2, 4-6, 8-10, and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 7, and 11-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 8, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1, 2, 5, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu(5,458,351).

Yu discloses a skateboard comprising front and rear footboards 20 with footpads 25, an elongated strut 10 pivotably connected to each of said footboards by a bracket arrangement 11 with vertical pivot axis 14 (or swivel-joints), and wheels 13 centered under the footpads, as shown in figures 1-3.

With respect to claim 10, conventional skateboards can tilt 30 degrees before contacting the ground.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu(5,458,351), as applied to claims 1-2 above, and further in view of Sheldon(4,082,306).

With respect to claims 4 and 8, Yu does not disclose the skateboard footboards as able to tilt relative to one another by a torsion bar. Sheldon does disclose a skateboard comprising a front and rear platforms able to tilt relative to one another by means of a torsion strut 30, which allows the footboards to, as shown in figures 1-4. It would have been obvious to one having ordinary skill in the art at the same time the

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invention was made to have given the skateboard, as taught by Yu, the torsion strut, as taught by Sheldon, in order to allow a user to turn the board more rapidly with less effort.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu(5,458,351), as applied to claim 1 above, and further in view of Meredith(4,458,9078).

Yu does not disclose the skateboard as being able to adjust to different lengths. Meredith does disclose a skateboard 10 as able to adjust to different lengths by a strut 38, as shown in figure 3. It would have been obvious to one having ordinary skill in the art at the same time the invention was made to have given the skateboard, as taught by Yu, the adjustable strut, as taught by Meredith, in order to allow the skateboard to adjust in length to accommodate users of different size.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu(5,458,351) and in further view of Sheldon(4,082,306).

Yu discloses a skateboard comprising front and rear footboards 20 with footpads 25, an elongated strut 10 pivotably connected to each of said footboards by a bracket arrangement 11 with vertical pivot axis 14 (or swivel-joints), and wheels 13 centered under the footpads, as shown in figures 1-3. Yu does not disclose the skateboard footboards as able to tilt relative to one another by a torsion bar. Sheldon does disclose a skateboard comprising a front and rear platforms able to tilt relative to one another by means of a torsion strut 30, which allows the footboards to, as shown in figures 1-4. It would have been obvious to one having ordinary skill in the art at the same time the invention was made to have given the skateboard, as taught by Yu, the torsion strut, as

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taught by Sheldon, in order to allow a user to turn the board more rapidly with less effort.

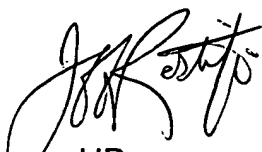
**Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lipscomb, Smith et al., Barachet, Yeh, Chambers, and Yu(695) all disclose skateboards of interest.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey J. Restifo whose telephone number is (703) 305-0579. The examiner can normally be reached on M-F (10:00-6:00), alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
JJR  
May 1, 2002

Jeffrey J. Restifo  
Examiner  
Art Unit 3618

  
BRIAN L. JOHNSON  
SUPERVISOR  
MAY 2 2002  
5/2/02